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AF 1617

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re the Application of James Hugh McLaughlin ) Group Art Unit  
Serial No.: 09/964,143 ) 1617  
Filed: September 25, 2001 ) Examiner  
For: Emollient Skin Conditioning Cream and Method ) Wang, Shengun

April 28, 2005

Commissioner For Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

**Filing of Reply To Examiner's Answer Under 37 CFR 1.193(b)**

Dear Sir:

Please find enclosed three (3) copies of Appellant's Reply To Examiner's Answer in the above-identified patent application. The filing of the Reply To Examiner's Answer is timely because mailing date of Examiner's Answer was 03/30/2005.

For your further information, Appellant will not be requesting an oral hearing because the enclosed Reply To Examiner's Answer fully sets forth Appellant's position.

Appellant renews the request for statement by U.S. Patent and Trademark Office of correct amount of fees payable in connection with Appellant's filing of this Appeal. The original request was made in the Notice of Appeal. To date no reply was received by Appellant. **The reply of some responsible person is requested again.**

Respectfully submitted

*Richard N. Miller*

Richard N. Miller  
Reg. No. 22,977

Enc. Reply to Examiner's Answer (3 copies)

I hereby certify that this paper along with enclosed three copies of Reply To Examiner's Answer are being deposited with the United States Post Office with sufficient postage as first class mail in an envelope addressed to the Commissioner Of Patents, P.O.Box 1450, Alexandria, VA 22313-1450 on      day of April, 2005, by Richard N. Miller. *Richard N. Miller*



**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/964,143  
Filing Date: September 25, 2001  
Appellants: McLAUGHLIN, JAMES HUGH

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Richard N. Miller  
For Appellant

**REPLY TO EXAMINER'S ANSWER**

This is in response to the Examiner Answer to Appellant's Brief On Appeal that was mailed on March 30, 2005.

(11) Response to Argument (Page 3 of Examiner's Answer)

The Examiner states in subparagraph 1 "Claims 3, 6, 33 and 40 – 43 are rejected under 35 U.S.C. 103 as unpatentable over Kellner in view of Barker et al." stating as follows:

"Kellner teaches that up to 20% of primary gelling agent may be used, wherein the preferred primary gelling agent is salt of fatty acid, particularly, calcium stearate (see col. 2, lines 24 – 65)." It is Appellant's position that said statement is not true and a person of ordinary skill in relevant art would know it was untrue for reasons that follow:

- A. Col. 2, lines 24 – 26, of Kellner state "The cosmetic stick compositions of the invention comprise 0.1-20%... of a primary gelling agent" and lines 61-63 state "Preferably the gelling agent... sodium stearate."
- B. Col. 2, lines 57 – 60, of Kellner state "Examples of gelling agents which may be used ...magnesium, calcium salts of stearic...acids...."
- C. Because the passage at col. 2, lines 24-65, does not identify the medium that is gelled, one skilled in art would have to refer to 9 examples to note in Example 1 that the medium gelled is sequence 6, i.e., water, and the gelling agent is sequence 8, i.e., sodium stearate. Further, one skilled in art would note that in the remaining eight examples the medium gelled was water and gelling agent was sodium stearate. Further, water content in the nine examples ranged from 37.7%-50.4% by weight.
- D. Since one skilled in the relevant art knows that calcium stearate and magnesium stearate according to CRC Handbook of Chemistry and Physics and Hackh's Chemical Dictionary are insoluble in water, a person of ordinary skill in art knows that said compounds cannot gel water and, therefore, said compounds are not equivalents of sodium stearate as gelling agents. (For the record, Merriam Webster

Collegiate Dictionary, Eleventh Edition, defines "equivalent as follows:

"corresponding or virtually identical esp. in effect and function.")

**The foregoing detailed analysis of disclosure of Kellner proves that a person of ordinary skill in relevant art would know that Kellner's statement that sodium stearate and calcium stearate or magnesium stearate are equivalents as gelling agents in Kellner's disclosed compositions is patently false and untrue and would not be led to include calcium stearate for any purpose in the compositions described by Kellner et al.**

Furthermore, if one skilled in art had any doubts that sodium stearate and calcium stearate were equivalent as gelling agents, he would substitute calcium stearate for sodium stearate as gelling agent in Example 1 of Kellner et al. and discover that the mixture of calcium stearate and water would not produce a gel and a Kellner's composition in form of solid stick could not be obtained. At that point, if one skilled in art still was not convinced that sodium stearate and calcium stearate were not equivalents as gelling agents, he would note that other eight examples contained 38% - 50% water and gelling agent was sodium stearate. Then he would substitute calcium stearate for sodium stearate in the composition of one of other examples and note that a composition in form of solid stick was not obtained. As a result of these experiments, **one skilled in relevant art would know Kellner's statement that sodium stearate and calcium were equivalents as gelling agents in Kellner's compositions was not true.**

Because the foregoing analysis shows calcium stearate and sodium stearate are not equivalents as gelling agents in Kellner, **one skilled in art has no reason to include calcium stearate or magnesium stearate in any of compositions of Kellner.** Thus, a person skilled in relevant art would conclude the following quotation from the Examiner's Answer was

contrary to the known facts and is based upon "wishful thinking" of person who is not skilled in art, e.g., the Examiner herein in Appellant's attorney's opinion:

"The employment of the particular ingredients such as corn starch or calcium stearate is obvious since they are known to be useful in the composition. The employment of such components in the composition is seen to be a selection amongst equally suitable material and as such obvious...(at 1388)." (Page 4, last paragraph, lines 8-11)

The foregoing analysis of Kellner et al proves that calcium stearate is not useful as a gelling agent in compositions of Kellner's examples. For further proof that sodium stearate and calcium stearate are not equivalents as gelling agents in Kellner's exemplified compositions, the members of Board of Appeal are referred to Exhibit C attached to Appellant's Appeal Brief Under 37 CFR 1.192.

Lastly, it is noted that the examiner agrees with Appellant's conclusion that Kellner's teaching that sodium stearate and calcium stearate are not equivalent as gelling agents in Kellner's composition of Example 1 containing 41% by weight of the water stating as follows:

"The examiner does not dispute that sodium stearate and calcium stearate are not equivalent as gelling agents in composition comprising 41% of water as as shown in the 1.132 Affidavit." (Next to last sentence in paragraph of Examiner's bridging pages 7 and 8.)

For the record, the 1.132 Affidavit deals with a reproduction of Kellner's composition of Example 1 with sodium stearate gelling agent and calcium stearate gelling agent substituted for said sodium stearate. Said affidavit verifies Appellant's contention that the said gelling agents are not equivalents in Kellner's composition of Example 1, thereby refuting Kellner teaching of equivalence. **Further, the foregoing quotation verifies that the Examiner**

**agrees with Appellant's conclusion that sodium stearate and calcium stearate are not equivalents as gelling agents.**

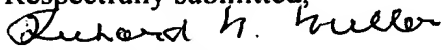
Furthermore, because the other eight Examples of Kellner contain similar amounts of water, e.g., 38% - 50% by weight of water, and sodium stearate as the gelling agent, they are further proof that Kellner's teaching that sodium stearate and calcium stearate are equivalents as gelling agents in Kellner's composition is untrue. **Thus, this analysis of Kellner proves that one skilled in art is not taught to include calcium stearate in compositions of Kellner for any purpose.** Therefore, no combination of the cited references of record teaches or suggests Appellant's novel and useful compositions containing the claimed proportions of emollient, surfactant, a mixture of starch and specific particulate material and 0-10% by weight of water thickened with calcium or magnesium C14 - C18 monocarboxylic acid salt.

The Examiner's Answer is silent with respect to an apparent essential ingredient, i.e., butylene glycol, that is present in every example of Kellner et al. patent, but is not discussed elsewhere in the specification of Kellner et al. or present in the claims of Kellner et al. (It Appellant's attorney's opinion that this fact with coupled shortcomings of Kellner et al. discussed above is further evidence that Patent Office was negligent in examination and prosecution of Kellner et al. patent application.) Because Appellant's compositions do not contain butylene glycol, this is further difference from the primary Kellner reference. Also, the Examiner sets forth no authority for the statement "The solid disclosed by Kellner et al. is actually a gel, which would meet the limitation of 'extrudable paste.'" The plain meaning of "A solid gel" is a solid, not an extrudable paste.

In summary, the detailed analysis of a primary reference to Kellner et al. discloses that Kellner's teaching that sodium stearate, calcium stearate and magnesium stearate are equivalent gelling agents for water in Kellner's disclosed composition is not true. The reason is that calcium stearate and magnesium stearate are insoluble in water and cannot gel water; whereas, sodium stearate is water soluble and effective to gel the continuous water phase. Thus, there is no reason for one skilled in art to include calcium stearate or magnesium stearate in the solid compositions of Kellner et al. and the Kellner et al. compositions without calcium or magnesium stearate do not make obvious Appellant's inventive compositions containing one of said water insoluble stearates in combination with an emollient, a surfactant, a mixture of starch and a specific other particulate ingredient and 0%-10% by weight of water.

Accordingly, Appellant's claimed inventive compositions are new, useful and unobvious from any fair combination of cited references. Further, the claimed compositions are in accord with 35 U.S.C. 101 – 103 and allowance of the claimed invention as a patent is respectfully solicited.

For the record, Appellant's attorney will not request oral hearing. If the decision of Board of Patent Appeals herein affirms the rejection of Examiner, Appellant's attorney will recommend filing civil action under 35 U.S.C. 145 and 146 to get justice. Appellant's attorney is educated as a chemical engineer, has over 35 years practice as a patent attorney and has never experienced such a technically unjustified rejection as in instant application.

Respectfully submitted,  
  
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